

REMARKS

Claims 1 through 21 are currently pending in the application.

Claims 1 through 15 have been withdrawn from consideration.

This amendment is in response to the Office Action of November 6, 2002.

Claims 16 through 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Deguchi (Japanese Patent No. 62-18714).

Claims 16, 19, and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kinoshita (Japanese Patent No. 58-90728).

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinoshita (Japanese Patent No. 58-90728) in view of Xu (U.S. Patent 5,908,319).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants submit that the presently claimed invention of amended independent claim 16 is not and cannot be anticipated under 35 U.S.C. § 102 by the Deguchi reference because the Deguchi reference does not describe identically each and every claim element, either expressly or inherently, in as complete detail as is contained in the claim. More specifically, the Deguchi reference does not describe the claimed element of the invention calling for "depositing a second layer of material having an upper surface thereof substantially free of depressions in the portion thereof covering said overlay target in said substrate". Applicants submit that the Deguchi reference contains no such description of such a claimed element of the invention whatsoever.

Therefore, presently amended independent claim 16 is allowable as well as dependent claims 17 through 21 therefrom.

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or inherently, in as complete detail as is contained in the claim. More specifically, the Kinoshita reference does not describe the claimed element of the invention calling for "depositing a second layer of material having an upper surface thereof substantially free of depressions in the portion thereof covering said overlay target in said substrate". Applicants submit that the Kinoshita reference contains no such description of such a claimed element of the invention whatsoever.

Therefore, presently amended independent claim 16 is allowable as well as dependent claims 17 through 21 therefrom.

Applicants further submit that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

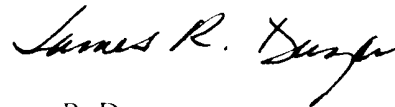
Regarding the rejection of claim 21 as being unpatentable over the Kinoshita reference in view of the Xu reference under 35 U.S.C. § 103, Applicants submit that any such rejection based upon such a combination of the cited prior art is clearly improper as such a combination of the cited prior art fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed invention of amended independent claim 16 and dependent claim 21 therefrom. Such a combination fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 because, at the very least, such a combination of the cited prior art does not teach or suggest all the claim limitations of the claimed invention. Applicants submit that the combination of the cited prior art does not and cannot teach or suggest the present claim limitation of presently amended independent claim 16 calling for "depositing a second layer of material having an upper surface thereof substantially free of depressions in the portion thereof covering said overlay target in said substrate". Neither the Kinoshita reference nor the Xu

Therefore, presently amended independent claim 16 and dependent claim 21 therefrom are allowable.

In summary, Applicants submit that claims 16 through 21 are clearly allowable over the cited prior art for the reasons set forth herein.

Applicants request the allowance of claims 16 through 21 and the case passed for issue.

Respectfully submitted,



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JRD/jml

Enclosure: Version with Markings to Show Changes Made

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

A marked-up version of each of the presently amended claims, highlighting the changes thereto, follows:

16. (Twice Amended) A method for forming an overlay target including a series of raised lines, the method comprising:
providing a substrate;
depositing a resist layer over said substrate;
patterning said resist layer to include a resist pattern defining said overlay target including a series of raised lines; [and]
etching said substrate to form said overlay target including said resist pattern with said series of raised lines; and
depositing a second layer of material having an upper surface thereof substantially free of depressions in the portion thereof covering said overlay target in said substrate.